

## REMARKS

Applicants appreciate the thoroughness with which the Examiner has examined the above-identified application. Reconsideration is requested in view of the amendments above and the remarks below.

### **Double patenting rejection**

Applicant will submit a terminal disclaimer with respect to the patent issuing from serial no. 10/707,183 once the claims of the instant application are indicated as being otherwise allowable.

### **Rejections under 35 USC § 103**

#### Claims 1, 3-11 and 15-18

Claims 1, 3, 6 and 17 stand rejected under 35 USC § 103 as being obvious from Gosselin et al. U.S. Patent No. 5,885,677 in view of Torgersen et al. U.S. Patent No. 4,303,701 further in view of Liu et al. U.S. Patent Publication No. US2002/0114929 A1.

Claim 4 stands rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701 further in view of Liu '929 and further in view of Cleary U.S. Patent No. 5,811,152.

Claim 5 stands rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701 further in view of Liu '929 and further in view of Howse et al. U.S. Patent No. 5,759,613.

Claims 7 and 8 stand rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701 further in view of Liu '929 and further in view of Van Duynhoven U.S. Patent No. 6,358,563.

Claim 9 stands rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701 further in view of Liu '929 and Van Duynhoven and further in view of Sims U.S. Patent No. 2,438,828.

Claim 10 stands rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701 further in view of Liu '929 and further in view of Small et al. U.S. Patent No. 4,927,663.

Claims 11 and 18 stand rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701 further in view of Liu '929 and further in view of Marsek U.S. Patent No. 5,104,711.

Claim 15 stands rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701 and further in view of Van Duynhoven.

Claim 16 stands rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701 and Van Duynhoven and further in view of Marsek '711.

Applicant respectfully traverses these rejections.

*Claims 1, 15 and 17*

Original independent method claims 1, 15 and 17 have been amended to recite that the method includes directly viewing the at least one paint layer at an acute angle to the object surface without use of an ultraviolet light "and without use of any intermediary layer," such that the unique discrete identification created by fluorescent material migrated into the at least one paint layer is visible at an acute angle to the object surface without the ultraviolet light "and any intermediary layer," while being substantially invisible at an angle normal to the object surface. Support is found in the drawings in Fig. 8 and in the specification at paragraph 0044 where the top paint layer

is directly viewed 68 at an acute angle without any intermediary layer over the paint layer. No new matter has been added.

Torgersen et al. U.S. Patent No. 4,303,701 requires the use of a fluorescent light to view the fluorescent material on the surface of a clear polycarbonate plastic lens. Gosselin et al. U.S. Patent No. 5,885,677 also requires the use UV light to read the image of the identifier pattern in the samples having UV-fluorescent dye. Neither Torgersen '701 nor Gosselin '677 disclose or suggest directly viewing a paint layer, in which a UV fluorescent material has migrated, at an acute angle without use of an ultraviolet light to view the identification created by the UV fluorescent material.

Liu et al. U.S. Patent Publication No. US2002/0114929 A1 discloses an article comprising a color shifting polymeric film and fluorescent indicia disposed behind the film. The color shifting film transmits different wavelengths of light as a function of angle, so that the indicia is viewable therethrough at different angles.

One of ordinary skill in the art would not initially think to combine Gosselin '677, Torgersen '701 and Liu '929 for the reasons previously given. However, even if one of ordinary skill did combine these references, none teach applicant's step as recited in amended claims 1, 15 and 17 of directly viewing the paint layer at an acute angle to the object surface without use of an ultraviolet light and without use of any intermediary layer to view the unique discrete identification, which is also substantially invisible at an angle normal to the object surface. Gosselin '677 and Torgersen '701 both use UV light to view their fluorescent indicia, and neither discloses that their images are viewable without use of an ultraviolet light at an acute angle, while also being substantially invisible at an angle normal to the object surface. Liu '929, which was cited for this teaching, requires the application over the colored portions of an

intermediary color shifting polymeric film in order to view the indicia at various angles. Liu '929's Fig. 1 shows a color shifting film 12 over the indicia 16 and 18 when viewed at normal incidence 24 and oblique angle 26. Liu '929 does not disclose or suggest directly viewing the identification in the paint layer without use of such intermediary layer, as applicant has unexpectedly discovered.

Van Duynhoven '563, cited for teaching that luminescent paint can be applied by brush and stencil, does not make up for the deficiencies of the primary cited art. Given the lack of teaching of such direct viewing of the image at an acute angle, without ultraviolet light or any intermediary layer, the hypothetical combination still would not result in applicant's claimed invention. Thus, claims 1, 15 and 17 represent are not obvious from a combination of Gosselin '677, Torgersen '701, Liu '929 and Van Duynhoven '563.

*Claims 11, 16 and 22*

Dependent claims 11, 16 and 22 recite a preferred embodiment of the method of the present invention wherein the paint is a urethane-based paint. The Gosselin '677, Torgersen '701, Liu '929 and Van Duynhoven '563 references do not disclose or suggest the use of their fluorescent markings with such a urethane-based paint system. The cited Marsek '711 patent discloses that a two-part catalyzed urethane paint system may be applied to a vehicle surface, but does not disclose or suggest that a liquid UV fluorescent material may be migrated into the urethane-based paint to permit the identification created by the fluorescent material to be visible at an acute angle to the surface, and substantially invisible at an angle normal to the surface. Accordingly, applicant's unexpected discovery of his invention in use with such a paint system

would not have been obvious from a combination of Gosselin '677, Torgersen '701, Liu '929 and/or Van Duynhoven '563 with Marsek '711.

#### Claims 19-23

Claims 19-21 stand rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701 further in view of Liu '929 and further in view of Jack U.S. Patent No. 5,151,572.

Claim 22 stands rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701, Liu '929 and Jack and further in view of Marsek '711.

Claim 23 stands rejected under 35 USC § 103 as being obvious from Gosselin '677 in view of Torgersen '701, further in view of Liu '929 and Jack and further in view of Rohrbaugh et al. U.S. Patent Publication No. US2002/0176982 A1.

Claim 19 has also been amended in a manner similar to claims 1, 15 and 17 to recite the step of directly viewing the unrevealed location of the vehicle surface at an acute angle without use of an ultraviolet light and without use of any intermediary layer to view the embedded unique discrete identification. Claim 19 as originally written also requires that, after applying the marking fluid in the form of the unique discrete identification at a desired, unrevealed location and removing excess fluid, the unique discrete identification and unrevealed location are recorded in a searchable database for retrieval in the event that the vehicle needs to be identified.

Claim 19 as amended is not obvious from Gosselin '677, Torgersen '701 and Liu '929 for the same reasons given in connection with claims 1, 15 and 17, above, particularly that these references do not disclose or suggest the direct viewing of the embedded UV fluorescent image at an acute angle, without ultraviolet light or any intermediary layer as in Liu '929.

The Jack '572 patent discloses that a "bar code reader may be used to read and input the to the computer various kinds of data, including, for instance, vehicle identification numbers (VIN) or serial numbers from automobile component parts." Column 3, lines 44-48. However, Jack '572 does not disclose or suggest that both the unique discrete identification as well as unrevealed location on the vehicle surface is recorded in the searchable database. This latter information is important since the unique discrete identification is difficult to see without UV light, except at an acute angle when looking at the particular unrevealed location.

While the Examiner has taken the position that "the window location is unrevealed to the public and thieves" in the Jack '572 publication, it is actually readily visible to all, unlike applicant's difficult-to-see unique discrete identification at a secret location in the vehicle paint. Even assuming that the Jack '929 window location is "unrevealed," there is still no disclosure or suggestion of recording this allegedly "unrevealed" location in a searchable database, as applicant claims. Accordingly, the Jack '572 patent in combination with the remaining cited references does not render obvious the method of claim 19.

Since the Marsek '711 and Rohrbaugh '982 references cited against claims 22 and 23, respectively, do not make up for the deficiencies of Jack '572, these dependent claims are also not disclosed or suggested by the cited art.

Applicants have amended and cancelled claims from further consideration in this application. Applicants are not conceding in this application that the claims as they stood prior to amendment are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution and allowance of the claims. Applicants respectfully reserve the right to

pursue these prior and other claims in one or more continuation and/or divisional patent applications.

It is respectfully submitted that the application has now been brought into a condition where allowance of the entire case is proper. Reconsideration and issuance of a notice of allowance are respectfully solicited.

Respectfully submitted,



Peter W. Peterson

Reg. No. 31,867

**DeLIO & PETERSON, LLC**  
121 Whitney Avenue  
New Haven, CT 06510-1241  
(203) 787-0595

vinm100001000amdB.doc